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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/216,206	12/18/1998	DAVID WILLIAM ROTH	B2745.0025/P0025	1079
7590 08/15/2006			EXAMINER	
BEH INVESTMENTS LLC 1652 48TH STREET BROOKLYN, NY 11204			VAN BRAMER, JOHN W	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 08/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/216,206	<b>Applicant(s)</b> ROTH ET AL.	
	<b>Examiner</b> John Van Bramer	<b>Art Unit</b> 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 May 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 49,50 and 62-218 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 49,50 and 62-218 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                    |                                                                             |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____                                                |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>081905</u> .                                                              | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submissions, filed on April 11, 2006 and May 1, 2006, have been entered.

### ***Terminal Disclaimer***

2. The terminal disclaimer filed on April 11, 2006 disclaiming the terminal portion of the patent being reexamined which would extend beyond the expiration date of U.S. Patent Number: 6,285,987 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Priority***


3. Applicant's claim for the benefit of a prior-filed application was added after the time period required by 37 CFR 1.78(a), therefore a petition under 37 CFR 1.78(a)(3) or (a)(6) must be filed and granted in order to obtain the benefit of the claimed priority date. Therefore, the priority date considered for the prosecution of the current claims is December 18, 1998.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

-  5. Claims 49, 50, 62-<sup>66</sup>~~65~~, 114-118, 166-170 and 218 are rejected under 35 U.S.C. 102(b) as being anticipated by Yager (Ronald R. Yager, "Intelligent Agents for World Wide Web Advertising Decisions", International Journal of Intelligent Systems, Vol. 12, pp. 379-390, 1997).

Claim 49: Yager discloses a computerized method for determining an advertisement from among a plurality of advertisements in response to an advertising opportunity, wherein the advertising opportunity is an opportunity to place the advertisement on a web page subsequent to a request for the web page by a viewer utilizing a browser, the computerized method comprising:

- a. Receiving in a computer network an indication of the advertising opportunity.

(Page 383, Paragraph 2)

- b. In response to receiving the indication: selecting in a computer the advertisement from among a plurality of advertisements associated with advertisers bidding in real time to fulfill the advertising opportunity. (Page 383, Paragraph 2)

Claim 50: Yager discloses the method of claim 49, wherein the indication of the advertising opportunity is received from the browser sending an HTML reference in the web page. (Page 382, Paragraph 6)

Claim 218: Yager discloses the method of claim 49, wherein each bidding advertiser is associated with a bid, the bid indicating a monetary amount billable to the each bidding advertiser if one of the plurality of advertisements associated with the each bidding advertiser is selected and served to the browser. (Page 382, Paragraph 3)

Claim 62: Yager discloses a method implemented in a computer system for determining in response to each advertising opportunity of a plurality of advertising opportunities, which advertisement of a plurality of advertisements to provide for fulfilling the advertising opportunity, the advertising opportunity being an opportunity to serve an advertisement to a browser in response to a request for content by the browser, the method comprising:

- a. Storing in the computer system the plurality of advertisements, each of the plurality of advertisements being associated with one of a plurality of sets of bidding parameters, the associated set of bidding parameters being indicative of whether a bid should be submitted for providing the each of the plurality of advertisements for fulfilling the advertising opportunity. (Page 384, Paragraph 1)
- b. Receiving in the computer system an indication of the request for content, thereby presenting the advertising opportunity. (Page 383, Paragraph 2)

- c. In response to the request for content: submitting in the computer system one or more bids, each submitted bid being based on one of the sets of bidding parameters, the one of the sets of bidding parameters being met by characteristics of the advertising opportunity, wherein the each submitted bid, in accordance with the one of the sets of bidding parameters, is indicative of a monetary amount billable to an advertiser associated with the each submitted bid upon occurrence of a specific event associated with an advertisement associated with the each submitted bid, the advertisement being one of the plurality of advertisements associated with the one of the sets of bidding parameters. (Page 383, Paragraph 2 through Paragraph 3)
- d. Selecting in the computer system a bid from among the submitted bids. (Page 384, Paragraph 1)
- e. Identifying in the computer system one of the plurality of advertisements associated with the selected bid, whereby the identified advertisement is determined by a bidding process. (Page 384, Paragraph 1)

Claim 114. Yager discloses a system for determining in response to each advertising opportunity of a plurality of advertising opportunities, which advertisement of a plurality of advertisements to provide for fulfilling the advertising opportunity, wherein the advertising opportunity is an opportunity to serve an advertisement to a browser in response to a request for content by the browser, the system comprising:

- a. A computer system having stored thereon:

- i. The plurality of advertisements. (Page 383, Paragraph 2, and Page 384, Paragraph 1)
- ii. For each of the plurality of advertisements, an associated set of bidding parameters, wherein the associated set of bidding parameters is indicative of whether a bid should be submitted for providing the each of the plurality of advertisements for fulfilling the advertising opportunity. (Page 387, Paragraph 3)
- iii. Programming code for receiving an indication of the request for content, thereby presenting the advertising opportunity. (Page 383, Paragraph 2)
- iv. Programming code for submitting, in response to the request for content, one or more bids, wherein each submitted bid is based on one of the sets of bidding parameters, wherein the one of the sets of bidding parameters is met by characteristics of the advertising opportunity, wherein the each submitted bid, in accordance with the one of the sets of bidding parameters, is indicative of a monetary amount billable to an advertiser associated with the each submitted bid upon occurrence of a specific event associated with an advertisement associated with the each submitted bid, the advertisement being one of the plurality of advertisements associated with the one of the sets of bidding parameters. (Page 383, Paragraph 2 through Paragraph 3)
- v. Programming code for selecting a bid from among the submitted bids. (Page 384, Paragraph 1)

- vi. Programming code for identifying one of the plurality of advertisements associated with the selected bid, whereby the system determines the identified advertisement by a bidding process. (Page 386, Paragraph 3; and Page 389, Paragraph 1 through 3)

Claim 166. Yager discloses a method implemented in a computer system for determining in response to each advertising opportunity of a plurality of advertising opportunities, which advertisement of a plurality of advertisements to provide for fulfilling the advertising opportunity, the advertising opportunity being an opportunity to serve an advertisement to a browser in response to a request for content by the browser, the method comprising:

- a. Receiving in the computer system an indication of the request for content, thereby presenting the advertising opportunity. (Page 383, Paragraph 2, and Page 384, Paragraph 1)
- b. In response to the request for content: determining in the computer system one or more bids, each determined bid being associated with one of the plurality of advertisements and being indicative of a monetary amount billable to an associated advertiser upon occurrence of a specific event associated with the one of the plurality of advertisements. (Page 383, Paragraph 2 through Paragraph 3)
- c. Selecting in the computer system a bid from among the determined bids. (Page 383, Paragraph 2 through Page 384, Paragraph 1)



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- d. Identifying in the computer system one of the plurality of advertisements associated with the selected bid. (Page 386, Paragraph 3; and Page 389, Paragraph 1 through 3)
- e. Serving the identified advertisement to the browser, whereby the identified advertisement is determined by a bidding process. (Page 384, Paragraph 1)

Claims 63, 115, and 167: Yager discloses the method of claims 62, 114, and 166 respectively, wherein the monetary amount indicated by each of the submitted bids is included in the each of the submitted bids. (Page 383, Paragraph 2 through Paragraph 3)

Claims 64, 116, and 168: Yager discloses the method of claims 62, 114, and 166 respectively, wherein the specific event upon which the monetary amount indicated by each of the submitted bids is billable, is a same event type for each of the submitted bids. (Page 383, Paragraph 2 through Paragraph 3)

Claim 65, 117, and 169: Yager discloses the method of claims 62, 114, and 166 respectively, wherein the specific event upon which the monetary amount indicated by at least one of the submitted bids is billable, is when the advertisement associated with the at least one of the submitted bids is served to the browser in fulfillment of the advertising opportunity. (Page 383, Paragraph 3)

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Claims 66, 118, and 170: Yager discloses the method of claims 65, 117, and 169 respectively, wherein the specific event upon which the monetary amount indicated by each of the submitted bids is billable, is when the advertisement associated with the each of the submitted bids is served to the browser in fulfillment of the advertising opportunity. (Page 383, Paragraph 3)

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 67-113, 119-165, and 171-217 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yager (Ronald R. Yager, "Intelligent Agents for World Wide Web Advertising Decisions", International Journal of Intelligent Systems, Vol. 12, pp. 379-390, 1997).

Claims 67, 70, 73, 76, 79, 119, 122, 125, 128, 131, 171, 174, 177, 180, and 183: Yager discloses the method of claims 62, 63, 64, 65, 66, 114, 115, 116, 117, 118, 166, 167, 168, 169, 170 respectively. Yager further discloses the user requesting content by the browser. (Page 383, Paragraph 6). Yager is silent with regard to the protocol used in transmitting the request from the browser, however it would have

been obvious to one of ordinary skill in the art at the time the invention was made to use the standard HTTP protocol for communicating between the website and the browser. One would have been motivated to use the standardized HTTP protocol in order to avoid the cost and expense of developing and distributing a customized transaction protocol to all potential customers.

Claims 68, 71, 74, 77, 80, 120, 123, 126, 129, 132, 172, 175, 178, 181, and 184:

Yager discloses the method of claims 67, 70, 73, 76, 79, 119, 122, 125, 128, 131, 171, 174, 177, 180, and 183 respectively, wherein the advertisement served to the browser in response to the request for content is included in a webpage accessed by the browser. (Page 384, Paragraph 1)

Claims 69, 72, 75, 78, 81, 121, 124, 127, 130, 133, 173, 176, 179, 182, and 185:

Yager discloses the method of claims 68, 71, 74, 77, 80, 120, 123, 126, 129, 132, 172, 175, 178, 181, and 184 respectively, wherein the request for content by the browser is caused by a reference in the web page. (Page 384, Paragraph 1)

Claims 82-96, 134-148, and 186-200: Yager discloses the method of claims 67-81, 119-133, and 171-185 respectively, wherein the selection of the selected bid is based on the selected bid indicating a highest monetary amount. (Page 386, Paragraph 3; and Page 389, Paragraph 1 through 3)

Claims 97-111, 149-163, and 201-215: Yager discloses the method of claims 67-81, 119-133, and 171-185 respectively, wherein the selection of the selected bid is based on the selected bid indicating a highest beneficial value. (Page 386, Paragraph 3; and Page 389, Paragraph 1 through 3)

Claims 112, 164, and 216: Yager discloses the method of claims 62, 114, and 185 respectively, wherein each submitted bid is associated with a bidding agent, wherein the each bidding agent submits the each submitted bid. (Page 383, Paragraph 2 through Paragraph 3; and Page 384, Paragraph 1)

Claim 113, 165, and 217: Yager discloses the method of claims 62, 114, and 185 respectively, wherein each submitted bid includes a reference to the advertisement associated with the each submitted bid. (Page 383, Paragraph 2 through Paragraph 3; and Page 384, Paragraph 1)

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hanson et al (U.S. Patent Number: 5,974,398), which discloses an advertisement bidding system similar to the applicants disclosure.

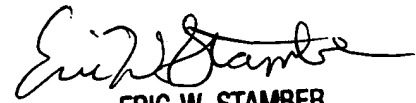
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Van Bramer whose telephone number is

(571) 272-8198. The examiner can normally be reached on 9am - 5pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

jvb

  
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